



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,965	12/20/1999	YOSHIHIRO TSUKAMURA	SON-1710	1790

7590 01/26/2004

RONALD P KANANEN ESQ
RADER FISHMAN AND GRAUER
THE LION BUILDING
1233 20TH STREET NW SUITE 501
WASHINGTON, DC 20036

EXAMINER

TRAN, TONGOC

ART UNIT	PAPER NUMBER
----------	--------------

2134

8

DATE MAILED: 01/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/466,965

Applicant(s)

TSUKAMURA ET AL.

Examiner

Tongoc Tran

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 04 November 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5 and 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to applicants' application amendment filed on 11/4/2003. Claims 3, 6-8 and 12-16 are cancelled. Claims 1-2, 4-5, and 9-11 are amended. Claims 1-2, 4-5 and 9-11 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-2, 4-5 and 9-11 are rejected under 35 U.S.C. 102(a) as being anticipated by Pare Jr. et al. (U.S. Patent No. 5,838,812).

In respect to claims 1 and 9, Pare teaches a system and method for identify an unknown user with a unique biometrics sample previously stored and can be networked between other computer systems carrying out all necessary executions (see abstract).

Art Unit: 2134

“the host computer comprising:

input means for inputting a user's instruction;

command output means for generating from the user's instruction an instruction command which request a predetermined processing to be executed and for outputting the instruction command (see col. 7, lines 50-60); and communication means for communicating with an external unit” (see col. 11, lines 28-35, col. 18, lines 5-27); and

a fingerprint identification apparatus comprising:

communication means for communicating with said host computer (see col. 12, lines 20-23);

processing control means for executing a predetermined processing according to the instruction command input from said host computer by said communication means (see col. 11, lines 47-50);

fingerprint detection means for detecting a fingerprint and for generating fingerprint data (see col. 11, lines 50-52);

storage-information recording means for recording the fingerprint data and storage information related to the fingerprint data (see col. 11, lines 54-56); and

fingerprint identification means for verifying fingerprint data detected by said fingerprint detection means with the fingerprint data recorded by said storage information recording means (see Fig. 24 and 25, col. 18, lines 30-34).

Wherein said storage-information recording means stores a private key generated by the public-key encryption method (see col. Col. 21, lines 35-40 and col. 22, lines 30-35), and

Wherein the user's instruction is one of a decryption of an encryption text and an encryption of plain text, and the user's instruction is sent to the host computer through communication cable (col. 7, lines 50-60).

In respect to claims 2 and 10, Pare discloses all the limitations as applied to claims 1 and 9 above. Pare further discloses:

"said storage-information recording means allows recorded storage information to be accessed only once immediately after the fingerprint-identification result is affirmative (see Fig. 24).

In respect to claims 4, and 11, Pare discloses all the limitations as applied in claims 1 and 9 above, Pare further discloses:

"said storage-information recording means stores a private key generated by the public-key encryption method (see col. 22, lines 27-35);

"said fingerprint identification apparatus further comprises encryption processing means for generating an encryption key, for performing encryption by the use of the encryption key, and for performing decryption" (col. 21, lines 35-45).

In respect to claim 5, Pare discloses all the limitations as applied to claim 4 above. Pare further discloses:

"said encryption processing means generates a public key and a private key according to the public key encryption method, and decrypts an encrypted text by the use of the private key, wherein the encrypted text is received from the host computer and decrypted plain text is sent to the host computer" (see col. 21, lines 35-40 and col. 22, lines 30-35, col. 7, lines 50-60).

Response to Arguments

4. Applicant's arguments filed 11/4/2003 have been fully considered but they are not persuasive. Applicants stated that Pare failed to teach the amended claims "that the user's instruction is one of a decryption of encrypted text or an encryption of plain text, and the user's instruction is connected to the host computer via a communication cable" (page 7 of amendment, first paragraph). The examiner disagrees. Pare teaches that "all" the communication between the user and the host (buyers and sellers) are encrypted using industry standard encryption technology (Pare, col. 7, lines 50-60). Since all the communication is conducted with encryption means, any instruction command that the user submits would have to be an encryption of plain text.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 2134

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Examiner Tongoc Tran

Art Unit: 2134

TT

January 20, 2004

Matthew L. Smithers
MATTHEW SMITHERS
PRIMARY EXAMINER
Art Unit 2137